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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/025,345	02/18/98	HINSHAW J	PMS-244198

PM82/0315

CUSHMAN DARBY & CUSHMAN
1100 NEW YORK AVENUE, N. W.
NINTH FLOOR
WASHINGTON, DC 20005-3918

EXAMINER	
MILLER, E	
ART UNIT	**PAPER NUMBER**
3641	14

DATE MAILED: 03/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/025,345	Hinshaw et al.
Examiner	**Group Art Unit**
Edward Miller	3641

☒ Responsive to communication(s) filed on *Dec 29, 1999*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1, 40, 78, and 81-115* is/are pending in the applicat

Of the above, claim(s) *40, 78, 81, 82, and 92-113* is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1, 83-91, 114, and 115* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. Applicants' response is regarded as an election of a single species of cobalt ammine nitrate and calcium stearate. The language used remains improper. See MPEP 806.04(e), where claims are not species. The use of claim language such as "including" is therefore improper in designating a single species. Likewise, "exemplary" is also improper. This requirement is made final. Claims, as understood, which read on the elected species are claims 1, 83-91, 114 and 115. The other claims are withdrawn from consideration as drawn to a nonelected species or invention.

2. The following is a quotation of 35 U.S.C. 103 which forms the basis for all rejections for obviousness set forth in this action:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102, which form a basis for rejections herein:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102 (b) as anticipated by Cook et al., Rausch, and Hommel et al.

These references teach compositions of ammine nitrate oxidizers, and thus anticipates the claims as best understood are anticipated.

4. Claims 1, 83-91, 114 and 115 are rejected under 35 U.S.C. 103 as being unpatentable over Cook et al. and Hommel et al., in view of Christmann et al.

Cook et al. and Hommel et al. teach compositions of metal ammine nitrates for use

in explosives. Christmann et al. teach that such nitrate explosives conventionally include water repelling agents of salts of fatty acids, col. 2, lines 66-68, as well as lubricants such as graphite or molybdenum disulfide, col. 3, lines 13-15. Use of calcium stearate for the water repelling agent, or the lubricants as taught, in the primary references would have been obvious. The specific cobalt ammine nitrates are notoriously well known, if not specifically taught, and substitution thereof would have been obvious for the similar ammine complexes. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinarily skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

5. Claims 1, 83-91, 114 and 115 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what the functional language, such as "formulated ..." in claim 1, line 1, e.g., means. This does not say how formulated or even what this refers to. This would appear to be an intended use, but it does not seem to state that exactly. Clarification is required. This is exemplary.

6. Claims 1, 83-91, 114 and 115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the prior invention as set forth in claims 31, 36, 49 and 66, e.g., of U.S. Patent No. 5,725,699. Although the conflicting claims are not identical, they are not patentably distinct from each other because of clear overlap.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent the improper extension of patent rights by prohibiting claims in a second patent which are not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970), *In re Kaplan*, 229 USPQ 678 (CAFC 1986). A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78(d).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163.

Examiner Miller may normally be reached daily, except alternate Fridays, from 8:30 AM to 6 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor, Mr. Jordan, can be reached at (703) 306-4159. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
March 13, 2000

EDWARD A. MILLER
PRIMARY EXAMINER